

REMARKS

Claims 1-21 are pending in the subject application. New claim 21 has been added to emphasize various novel aspects of the subject invention already recited in pending claims. Accordingly, this claim does not raise issues requiring further search or effort on behalf of the Examiner. A listing of all claims is at pages 2-5. Favorable consideration in light of the new claim and the remarks which follow is respectfully requested.

The Obviousness Rejection

Claims 1-20 are rejected under 35 U.S.C. 103(a) over Li, et al. (US 2003/000017623). It is respectfully submitted that this rejection should be withdrawn for the following reason. Li, et al. does not teach or suggest all the limitations of the subject claims and, thus, does not make obvious the claimed invention.

In the subject Office Action (dated February 3, 2004), it is conceded that Li, et al. "fails to disclose the steps of forming a silicon-based resist layer on the organic semiconductor layer and then patterning the organic semiconductor layer using the silicon-based resist as a mask," but the Examiner asserts this step would be obvious to one of ordinary skill in the art at the time of the invention. (See Office Action, p.3, ¶1). Applicants' representative respectfully traverses this allegation because there is no suggestion or motivation in Li, et al. to make the purported modification.

In particular, Li, et al. is directed to electrode-to-ferroelectric polymer memory structure adhesion techniques and containing volatile fluorine based materials. (See p.3, ¶ [002]). In contrast, the subject claims relate to mitigating difficulties associated with patterning organic polymer semiconductors. (See application, p.2, ll.10-13). Specifically, conventional patterning techniques typically employ carbon resists, and when carbon resists are utilized with organic polymer substrates, which are also carbon-based, difficulties arise because conventional patterning technique cannot discriminate between the carbon resist and the organic polymer substrate. (See

application, p.2, ll.13-16). The claimed invention at least overcomes this issue via utilizing a silicon-based resist as a mask for an organic polymer semiconductor. Li, et al. does not contemplate this issue, let alone provide a suggestion or motivation to make the purported modification.

The Examiner is reminded that upon traversal of such assertion, he must provide documentary evidence in the next Office Action if the rejection is to be maintained (See 37 CFR 1.104(c)(2); See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test) or if the examiner is relying on personal knowledge to support this allegation, he must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding (See 37 CFR 1.104(d)(2)).

Since Li, et al. is silent regarding improving patterning techniques, it appears the Examiner is modifying Li, et al. via employment of applicants' specification on a 20/20 hindsight (blueprint) based reading to provide this missing claimed limitation. *Interconnect Planning Corporation v. Thomas E. Feil, Robert O. Carpenter, V Band Systems, Inc., and Turret Equipment Corp.*, 774 F.2d 1132, 1138 (C.A.Fed. 1985.); 227 USPQ 543 (stating the invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time). See also *Stewart-Warner Corp. v. City of Pontiac, Michigan*, 767 F.2d 1563, 1570 (Fed.Cir.1985), 226 USPQ 676, 680-81. The rationale proffered to modify Li, et al. is to achieve benefits identified in applicants' specification. Applicants' representative respectfully submits that this is an unacceptable and improper basis for a rejection under 35 U.S.C. 103. In essence, this rejection is based on an assertion that it would have been obvious to do something not suggested in the art because so doing would provide advantages stated in applicants' specification. This sort of rationale has been condemned by the Court of Appeals for the Federal Circuit. See, for example, *Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987). In addition, the mere fact that the

reference can be modified does not render the modification obvious unless the referenced art also suggests the desirability of the modification. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

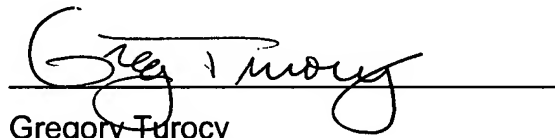
In view of the foregoing, it is respectfully requested that the rejection of claims 1-20 be withdrawn.

Should the Examiner believe that a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

In the event any fees are due in connection with the filing of this document, the Commissioner is authorized to charge those fees to our Deposit Account No. 50-1063.

Respectfully submitted,

AMIN & TUROCY, LLP

A handwritten signature in cursive script, appearing to read "Greg Turocy", is written over a horizontal line.

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